



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,761	03/26/2004	Charles H. Honeyman	H-368	9073

26245 7590 01/28/2005

DAVID J COLE
E INK CORPORATION
733 CONCORD AVE
CAMBRIDGE, MA 02138-1002

EXAMINER

THOMPSON, TIMOTHY J

ART UNIT	PAPER NUMBER
----------	--------------

2873

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,761

Applicant(s)

HONEYMAN ET AL. 

Examiner

Timothy J Thompson

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
4a) Of the above claim(s) 34-37 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-33 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 18 is/are rejected.
- 7) ☒ Claim(s) 3-17 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-33, drawn to an electro optic assembly, classified in class 359, subclass 296.
- II. Claims 34-37, drawn to an adhesive, classified in class 524, subclass 556.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive for use with semiconductors and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 2873

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with David Cole on 01/27/2005 a provisional election was made without traverse to prosecute the invention of the electrooptic device, claims 1-33. Affirmation of this election must be made by applicant in replying to this Office action. Claims 34-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gauthier et al.(U.S. Patent No. 5,130,842).

Regarding claim 1, Gauthier et al. discloses first and second substrates(fig 1, 20, 22), and an adhesive layer(fig 1, 10), the adhesive layer comprising a mixture of a polymeric adhesive material and an additive selected from a salt, a polyelectrolyte, a polymer electrolyte, a solid electrolyte, and combinations thereof(lines 40-45, and col 7, lines 33-37).

Art Unit: 2873

Regarding claim 2, Gauthier et al. discloses the adhesive layer comprises a mixture of the polymeric adhesive material and a salt(col 4, lines 40-45).

Regarding claim 18, Gauthier et al. discloses first and second substrates(fig 1, 20, 22); an adhesive layer(fig 1, 10) and a layer of electro-optic material disposed substrates(fig 1, 12, 14), and between the first and second substrates, the adhesive layer comprising a mixture of a polmeric adhesive material and an additive selected from a conductive metal powder(col 4, lines 60-68).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lees et al.(U.S. Patent No. 3,540,008).

Regarding claim 1, Lees et al. discloses first and second substrates(fig 2, 10, 38), and an adhesive layer(fig 1, 36), the adhesive layer comprising a mixture of a polymeric adhesive material and an additive selected from a salt, a polyelectrolyte, a polymer eleckolyte, a solid electrolyte, and combinations thereof(col 5, lines 29-35).

Allowable Subject Matter

Claims 3-17,19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 20-33 are allowed.

Art Unit: 2873

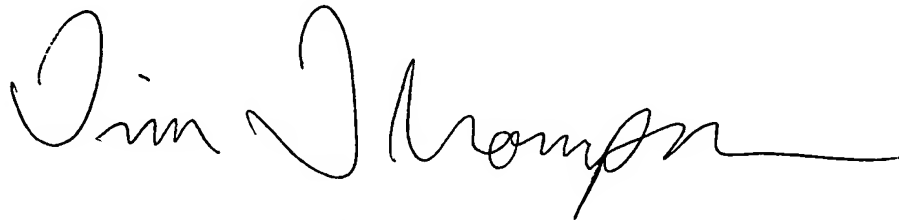
The following is an examiner's statement of reasons for allowance: The prior art taken either singularity or in combination fails to anticipate or fairly suggest the limitations of the independent claim, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claims 20, 21, 33, with the allowable features being the specific type of adhesive material used (claims 20, 21, 33). Therefore claims 20-37 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Thompson whose telephone number is (571) 272-2342. If the examiner can not be reached his supervisor, Georgia Epps, can be reached on (571) 272-2328.

T.J.T.
1/27/05



TIMOTHY THOMPSON
PRIMARY EXAMINER